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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,795	05/21/1999	RONALD P. SANSONE	E-846	8309
919 7590 06/12/2009 PITNEY BOWES INC. 35 WATERVIEW DRIVE MSC 26-22 SHELTON, CT 06484-3000				
EXAMINER				
NGUYEN, NGA B				
ART UNIT		PAPER NUMBER		
3692				
NOTIFICATION DATE		DELIVERY MODE		
06/12/2009		ELECTRONIC		

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/316,795
Filing Date: May 21, 1999
Appellant(s): SANSONE ET AL.

Ronald Reichman (Reg. No. 26,796)

For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed on March 3, 2009 appealing from the Office action mailed on April 27, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The statement of the status of Amendments contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1 and 6-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 and 6-22 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 1 and 6-22 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion *Ex parte Langemyer et al*.

(7) Claim Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence relied Upon

US 6,006,200	Boies et al.	12-1999
US 5,452,203	Moore	09-1995
US 6,005,945	Whitehouse	12-1999
US 5,420,403	Allum et al.	05-1995
US 5,422,821	Allen et al.	06-1995

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

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2. Claims 1 and 6-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 1 and 6-22 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion *Ex parte Langemyer et al.*

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al. (6,006,200) in view of Moore (5,452,203), Whitehouse (6,005,945) and Allum et al. (5,420,403).

With regard to claim 1, Boies et al. teaches a method for forwarding mail by a post that is addressed to a recipient at a virtual post office box to be delivered directly to a recipient without the recipient going to the post (SEE Boies et al. figure 1 and abstract), said method comprises the steps of: receiving recipient's name and recipient's desired delivery address (SEE Boies et al. figure 2A, item 203 "COLLECT MAILING ADDRESS INFORMATION") assigning a virtual post office box identification for individual recipients (SEE Boies et al. figure 1 item 16 column 2, lines 14-16 "The personal identifier is a multi-digit numeric or alphanumeric code assigned to a customer), relating recipient's virtual post office box with the desired delivery address of the recipients (SEE Boies et al. figure 1, item 10), delivering to recipients their assigned virtual post office box's identification (SEE Boies et al. column 2, lines 15-25 and see figure 2B item 209 "SEND IT BACK TO USER"), placing virtual post office boxes on mail (SEE Boies et al. figure 2C items 217 and 218), reading mail to capture virtual post office box identification, when present (SEE Boies et al. figure 1, items 10 and 14 and column 2, lines 18-22 and 60-64), determining recipient's desired delivery address from virtual post office box identification (SEE Boies et al. figure 1, items 10 and 14 and

column 2, lines 18-22 and 60-64), determining in **one or more data bases that recipient's name is listed with recipient's desired delivery address and is the address to which the owner of the virtual Post office box wants the mail forwarded, wherein the forwarding information may be sent by telephone physical mail or facsimile**

(SEE Boies et al. these features are illustrated in detail in figures 2A, 2B and 2C and column 2, wherein Boies et al. illustrates that a customer (**or recipient**) would give the customer number (or virtual **post office box identification**) to a seller, who in turn, would give the customer number to the shipper (e.g. UPS / **FedEX / Post office**) and wherein SEE column 2, lines 18-22;

"The shipper 14 is the creator and custodian of the codes. It generates a unique code for each customer, which code is associated with the customer's full **shipping address and, optional the customer's name**, permitting shipment to be made to the customer 16"), and delivering mail to the desired delivery address of the recipients (SEE Boies et al. column 2, lines 60-64).

Boies et al. does not illustrate placing recipient's desired delivery address on mail in coded form and human readable form. Boies et al. instead illustrates in figure 1, item 10 the address in "human form" but in view of the highly automated sorting of mail as it travels across the county interfacing at multiple points it would have been logical to have put both machine form and readable form wherein the readable form is used during last mile by a human mail man.

Allum discloses the use of coded form, human readable form or both to print a delivery label (SEE Allum figures 7 and 8) to facilitate the routing of the mail automatically and to assist the delivery person to find the correct delivery address. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Boies et al. by adopting the teaching of Allum to facilitate the faster routing of the packages automatically and to assist a delivery person to find correct delivery addresses.

And further Boies et al. does not clearly illustrate using the, "recipient's name", when determining recipient's desired delivery address he instead clearly illustrates using a multi-digit identifier item 16 "(#71134U47B)", however figure 1 does illustrate the title "CUSTOMER" clearly on a separate line above item 16 the multi-digit identifier and especially note it's in all capital letters, and in view of this it is reasonable to contend that one of ordinary skill looking at Figure 1 would think the word "CUSTOMER" was suggestive of some "NAME" given by user along with his multi-digit identifier below it.

This obvious interpretation would be in step with the established conventional practice, for example it has been a common practice to put the NAME of the PERSON or BUSINESS, GOV AGENCY above the post office box # when addressing letters. Another example would have been where most forms require both a legal NAME and a social security number or employee number for proper identification purposes. And still further it has been a common practice when logging into a computer or web site where one has an account to provide a USERNAME and a password, whereby the

USERNAME was creatively selected by the user and this NAME would have been some form of his legal name or a chosen nick name keeping secret his real name.

This suggested interpretation or modification of the Boies et al. method would have been in step with the objective of the Boies al. invention for example column 3, lines 4-6 state, "The benefit for the customer is that a LEVEL of anonymity is established for the transaction." Clearly the Boies et al. objective of keeping his actual mail address off the direct marketing mailing lists would have been maintained (SEE Boies et al. column 1, lines 1-35). And still further two references are listed below to provide evidence to the well known statements made above.

Moore (5,452,203) illustrates "CORRECTING CUSTOMER ADDRESS" (SEE title) and teaches the well known practice of putting the NAME of the PERSON or BUSINESS, GOV AGENCY above the post office box # when addressing letters (SEE Moore column 1, lines 57-59 "Pitney Bowes, Inc., Box 3000").

Whitehouse (6,005,945) illustrates "DISPENSING POSTAGE" (SEE title) and teaches the well known practice of providing at least two fields of information for proper Whitehouse column 12, lines 57-65 "The central computer, after decrypting the request message, validates the postal indicium request by verifying the digital signature, if any, in the request, and validating the meter or account ID and account password in the request message (step 202, by validation procedure 161). If the meter/account ID does not correspond to an active postage dispensing account, or if the password is incorrect, an error message is returned to the request sender.").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to interpret or modify the Boies et al. to clearly use the "NAME feature", because Boies et al. as stated above provided suggestion and further irregardless, the analysis prior mail art of Moore and Whitehouse also suggested it wherein they simply teach it is was a well known practice use a NAME with the identification number and still further as additional added motivation Whitehouse provided a means for error checking which would have been used by Boies et al.

With regard to claim 6 the combination of Boies et al., Moore, Whitehouse, and Allum et al. teaches the method claimed in claim 1, further including the step of. changing recipient's desired delivery address in accordance with recipient's Instructions (SEE Boles et al. column 4, lines 12-15 "notifying by a customer a change").

With regard to claims 7 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the method claimed in claim 6, "wherein in the changing step: recipient specifies the time period In which mail is going to be delivered to the desired delivery address". However, it is an old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the post Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been involved in simply having employed this old well-known practice for the claimed method to facilitate efficient mail delivery.

With regard to claims 8, 9 and 10 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the well-known details whereby the method claimed in claim 1, further including the step of: billing for the number of times recipient's changed their desired delivery address, metering the number of times recipient's desired delivery address was determined, and billing for the number of times recipient's desired delivery address was determined (however it was a fundamental practice of the service provider to charge when services are used and changed and at the end of the billing cycle providing a metering of these services in a billing statement as a means of making more money. Thus, it would have been within the level of ordinary skill in the art to employ this fundamental practice to the claimed method to increase the profit.

With regard to claim 11 the combination of Boies et al., Moore, Whitehouse, and Allum et al. teaches the method claimed in claim 1, wherein recipients virtual post office box is represented in alphanumeric characters (SEE Boies et al. column 2, lines 14-16).

With regard to claims 12 and 13 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the well-known details whereby the method claimed in claim 1, further including the steps of: (a) assigning access codes to recipients that are related to recipient's virtual post office box, (b) delivering access codes to recipients, (c) receiving recipient's name, access code and recipient's intention to change their delivery address, and (d) changing recipient's delivery address upon conformation of recipient's name and access code and (e) confirming recipient's

virtual post office box (However SEE Boies et al. column 4, lines 12-15 "notifying by a customer a change" wherein of course, to keep anonymity and privacy (see the abstract of Boies), the use of the claimed steps of a-e would have been obvious).

With regard to claim 14 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the method claimed in claim 12, wherein in the changing step: recipient specifies the time period in which mail is going to be delivered to the changed delivery address (however SEE response to claim 7 above where this feature was covered).

With regard to claim 15 the combination of Boies et al., Moore, Whitehouse, and Allum et al. teaches the method claimed in claim 12, further including in the changing step, the steps of: (a) assigning a biometrics to recipients, (b) delivering the biometrics to recipients, (c) receiving recipient's biometrics and recipient's intention to change their delivery address, (d) changing recipient's delivery address upon conformation of recipient's biometrics, (However SEE Boies et al. column 4, lines 12-15 "notifying by a customer a change" wherein of course, to keep anonymity and privacy (see the abstract of Boies), the use of the claimed steps of a-d would have been obvious and within the level of ordinary skill in the art. More specifically, it would have been obvious to assign a biometrics such as for example a finger print to recipients that are related to each recipient's virtual post office box to prevent others from accessing unauthorized post office boxes.

With regard to claims 16, 17, 18, 19, and 20 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate all of the standard conventional practices whereby the method claimed In claim 12, wherein recipient's name, access code and recipient's intention to change their delivery address will be received by telephone, facsimile, computer, in person, received by mail, (However SEE Boies et al. column 4, lines 12-15 "notifying by a customer a change" wherein those above methods of communications are all well-known methods as desired to notify the changes of the personal information to effect the change of the address and further the one you use is not critical to the practice of Boies et al. or applicant.).

With regard to claim 21 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate the method claimed in claim 12, wherein recipient's access code is encrypted (however, it is a well-known practice in the art to encrypt any vital information in the art to prevent fraudulent access of personal account or database and it would have been common sense to employ this well-known practice for the claimed method to further enhance the anonymity and privacy (SEE the abstract of Boies) of the recipient.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Boies et al., Moore, Whitehouse, and Allum et al. as applied to claim 1 above, and further in view of Allen (US PAT 5,422,821).

With regard to claim 22 the combination of Boies et al., Moore, Whitehouse, and Allum et al. does not illustrate, "wherein one of the data bases is the National Name and Address Data Base".

However Allen teaches the use of the National Name and Address Data Base (i.e., US PS National Change of Address database) to identify, intercept and forward incorrectly addressed mail pieces (SEE Allen et al. column 2, lines 57-68).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the combination of Boies et al., Moore, Whitehouse, and Allum et al. because he teaches how to identify, intercept and forward incorrectly addressed mail pieces.

(10) Response to Argument

Regarding to claims 1 and 6-21, in response to the appellant's arguments that Boies does not disclose "determining one or more data bases that recipient's name is listed with recipient's desired delivery address and is the address to which the owner of the virtual post office box wants the mail forwarded, wherein the forwarding information may be sent by telephone, physical mail, or facsimile", examiner submits that Boies discloses in column 2, lines 10-30 that a third party vendor to supply a unique identifier to the customer that maps to the customer's name and address in a database owned by the third party; the shipper generates a unique code for each customer, which code is associated with the customer's full shipping address and optimally, the customer's

name, permitting shipment to be made to the customer; the association is maintained as a private database by the delivery organization. Moreover, also in column 2, lines 55-60, Boies teaches when the vendor receives the order, the vendor creates a printed, machine readable representation of the address code on the shipping label and the package is sent to the shipping company, the shipping company uses the machine readable address code to access the master file to retrieve the user' shipping address for delivery of the package. Therefore, ***Boies does disclose "determining one or more data bases that recipient's name is listed with recipient's desired delivery address and is the address to which the owner of the virtual post office box wants the mail forwarded, wherein the forwarding information may be sent by telephone, physical mail, or facsimile."***

Regarding to claims 1 and 6-21, in response to the appellant's arguments that "in rejecting a claim under 35 U.S.C. 103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion", examiner would like to point out that the Supreme Court in KSR described rationales to support rejections under 35 U.S.C. 103 : Combining prior art elements according to known methods to yield predictable results; and Simple substitution of one known element for another to obtain predictable results. The combination of Boies et al., Moore, Whitehouse and Allum et al. would yielded predictable results as described in the section (9) Ground of Rejection above. Therefore, ***the claims are obvious under KSR.***

Regarding to claims 6 and 7, in response to the appellant's arguments, examiner would like to point out that the Supreme Court in KSR described rationales to support

rejections under 35 U.S.C. 103 : Combining prior art elements according to known methods to yield predictable results; and Simple substitution of one known element for another to obtain predictable results. In this case, the well-known feature “specify the time period in which mail is going to be delivered to the changed delivery address” can be employed for the claimed method to facilitate efficient mail delivery. Thus, the feature is combining with Boies et al., Moore, Whitehouse, and Allum et al. would have yielded predictable results. Therefore, ***the claims are obvious under KSR.***

Regarding to claims 8-21, in response to the appellant's arguments that "the Examiner has not cited any art in the context of the claimed invention...", examiner submits that the appellant has not submitted any rebuttal of the well-known statements, the applicant has not presented arguments that the features are not well known. This does not constitute a proper challenge to the well-known statements.

(11) Related Proceedings Appendix

The statement of the related proceedings appendix contained in the brief is correct.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above.

Accordingly, appellant must within TWO MONTHS from the date of this answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) Maintain appeal. Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

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